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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,065	11/20/2003	Herman Rodriguez	AUS920030852US1	8673
35525	7590	01/27/2009		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER NGUYEN, THUY-VI THI	
			ART UNIT 3689	PAPER NUMBER
			NOTIFICATION DATE 01/27/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeciipaw.com

### Office Action Summary

**Application No.**

10/718,065

**Applicant(s)**

RODRIGUEZ ET AL.

**Examiner**

THUY VI NGUYEN

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This is in response to the applicant's communication filed on 09/15/08, wherein:  
Claims 1, 11, 12, 13, 21, have been amended;  
Claims 1-28 are currently pending.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1 and 11** are reject under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims **1, 10, 12** the claim language does not transform the underlying subject matter and the process is not tied to another statutory class. The process steps of "*comparing...; generating...; sending...; determining...; forming...; making...; confirming....*" is not tied to another statutory class, such as an apparatus, and thus, the claims are directed to nonstatutory subject matter.

Here claims 1 and 11 fail to meet the above requirements since there is not a sufficient tie to another statutory class (2) transformation, and thus is directed to nonstatutory subject matter. Insertion of the use of another statutory class (computer) such as "computer-implemented" or "using a computer" features in the preamble and the critical functions/bodies of the claims would overcome the rejections.

**Claims 21-28** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims are directed to computer-readable medium which can be a signal as defined in the specification {par 0063}. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 11, 12, 13, and 21, the steps calls for " responsive to one of the first comparison and the second comparison being a complete match between the user preferences and the available resources, making the reservation user the user preferences" is vague and indefinite. It's not clear "the first comparison" feature being a

complete match since it is not a complete match in a previous step (c). Furthermore, it is not clear the feature "making the reservation using the user preferences" is related with the first comparison in steps (c-d)) or the second comparison in steps (c-g). The claim language looks like the reservation is made using the user preferences at the first comparison step, but not using the reservation details which are received by the user.

**In claims 13-20**, claim element "means for receiving ...., means for determining...." is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Applicant's specification appears not to disclose "means for providing..., means for receiving..., means for comparing..., means for generating..., means for determining..., means for forming..., means for making..., means for confirming...". Therefore, applicant is required to

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. F& more information, see 37 CFR 1.75(d) aid MPEP 21si and 608.01(0).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over CANNON ET AL (US 2002/0082142) in view of TANG (US 2004/0001575)

**As for claim 1**, CANNON ET AL disclose a method for making reservations, the method comprise:

a) providing a wireless hot spot location, wherein reservations can be made with a plurality of vendors through the wireless hot spot;

{see figures 1-2, pars. 0011-0012, 0014; providing a communication such as Bluetooth between user interface (wireless telephone) and reservation system database which has different exercise facilities in different cities for the user to select the desired location for making the reservation. The term "hot spot" location is merely a description of a location whereby wireless communication is effective/sufficient/good and this feature is taught in the cited portion above whereby "communication by Bluetooth technology is carried out effectively/sufficiently}}

b) receiving a user request, including user preferences, to make a reservation from a wireless device in communication with the wireless hot spot, wherein the request is to a selected vendor from the plurality of vendors

{see figures 2 (step13), pars. 0012-0014, discloses receiving a user request including user preferences e.g. the desired exercise equipment, preferred day and time of use, preferred time duration of use etc, and the user can enter the desire location of the exercise equipment};

c) comparing the user preferences with available resources of the selected vendor, wherein a first comparison is formed

{see figures 2 (step 17), pars. 0012-0014; compare user's request for fitness machine type, data , time and location with that fitness machine availability/available resources};

h) making the reservation using the user preferences {see figure 2, steps 23-26}

i) confirming the reservation {see figure 2, par. 0014, advising the reservation has been made}

CANNON ET AL further disclose notify the user when the first comparison not being a complete match between the user preferences and the available resources (step d) {figure 2}, and forming a second comparison (additional request from user if the first request is not available) {figure 2}. CANNON ET AL disclose all the claim invention indicated above except for the feature "generating reservation details, sending the reservation details to the user" (step e), "determining whether the reservation details are accepted by the user" (step f) and "forming a second comparison when the reservation details are accepted (step g)".

In the similar concept for generating the reservation system using the voice user interface based appointment /reservation system for the benefit of helping user to quickly find and reserve the available time slot of his preference {pars. 0017}, TANG discloses generating and sending the reservation details to the user, {figure 6B (step 6009); par. 0177 e.g. *providing the alternative dates that are closed to user's preference*}; determining whether the reservation details are accepted by the user {see figure 6B, step 6009}; and forming a second comparison when the reservation details are accepted {see figure 6B, step 6009 "*check available time*"}) and making a reservation using user preference {see figure 6C, step 6011 and 6012}. It would have been obvious to one of ordinary skill in the art to provide the method CANNON ET AL to include the sending reservation details feature as taught by TANG in order to help the user to quickly find and reserve an appointment/reservation of his preferences as well as reducing the business cost for not requiring human resource when using the automated reservation system. {TANG par. 0008, 0017}.



Note: This is a method claim, and active, positive method step is required. As for the phrase "to make a reservation; is to a selected vendor; .... *to identify a set of software applications* ...", this is not a positively recited method step but, rather as intended use of the previous step/function.

**Note:** for convenience, letters (a)-(i) are added to the beginning of each step.

As for dep. claims 2-3, which deal with the locations of the user preferences/data e.g. the wireless device, in a data processing system, this is fairly taught in CANNON ET AL {pars. 0011 and pars. 0014}.

As for dep. claim 4, which deals with the wireless device parameter, e.g. digital wireless phone, this is fairly taught in CANNON ET AL {pars. 0011 and pars. 0014 and figure 1}.

As for dep. claims 5-6, which deals with the user preferences/information are associated with the selected one of the plurality of vendors and the vendors are a set of registered vendor, this is fairly taught in CANNON ET AL {par. 0011-0012, reservation system database including different facilities from different cities for user select his/her desire location}.

As for dep. claim 7, which deals with user preference parameter e.g. time and order information, this is fairly taught in CANNON ET AL {figure 2, steps 13-17}. Furthermore, this appears to be a "data processing" method, therefore, the term "*time, location, order information*" in the "in the user preferences" have been determined to be non-functional descriptive material (NFDm), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render

nonobvious an invention that would have other wise been obvious. See MPEP 2106.01.

As for dep. claim 8, which deals with plurality vendors parameter e.g , a reservation service etc, this is fairly taught in CANNON ET AL {figure 2, steps 13-17}. Furthermore, this appears to be a "data processing" method, therefore, the term "*restaurant, hotel, a reservation service*" in the "vendors" have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. See MPEP 2106.01.

As for dep. claim 9, which deals with the charging feature to the user or customer, this charging feature is common, old and well know in the art. It would have been obvious to one of ordinary skill in the art to charge the customer for providing the service to the customer e.g. providing the internet service for customer to get access into the website of the vendor for making a reservation in order to gain the profit or revenue for providing a service.

As for claim 10, which deals with the providing Internet after making the reservation, this is fairly taught in CANNON ET AL {figure 1}.

As for independent claim 11, which deals with a method in a wireless data processing system for making reservations, basically this claim has the similar limitations as the rejected independent claim 1 above. It is rejected for the same reason sets forth the independent claim 1 indicated above.

As for independent claim 12, which deals with a data processing system for making reservations comprising a bus system, a communication unit connected to the bus system, and a memory connected to the bus system, and a processing unit connected to the bus system, this is inherently included in CANNON ET AL, see figure 1, par. 0011 for the connection system between the computer/processing unit 10 with the databases/memory. Basically, this claim has the similar limitation as the independent claim 1 above. It is rejected for the same reason sets forth the independent claim 1 stated above.

As for the independent claim 13, basically this claim deals with the means for that carries the method steps of the independent claim 1, it is rejected for the same reason sets forth the independent claim 1 above.

As for the dep. claims 14-20, basically these claims have the same limitation as the dep. claims 1-8, they are rejected for the same reason sets forth dep. claims 1-8 above.

As for independent claim 21, which deals with a computer readable medium having the instructions which carry the method steps of the independent claim 1 above, it is rejected for the same reason sets forth the independent claim 1 indicated above.

As for the dep. claims 22-28, basically these claims have the same limitation as the dep. claims 1-8, they are rejected for the same reason sets forth dep. claims 1-8 above.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ThuyVi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
January 16, 2009

